

**REMARKS**

These remarks are responsive to the Office Action mailed July 27, 2007 ("Office Action"). Applicants respectfully request reconsideration of the rejection of claims 16-43, 45-47, and 49-56 for at least the following reasons.

**I. Status of Claims**

Claims 16-43, 45-47, and 49-56 are pending with claims 16, 23, 29, 35, 41, 45 and 49-55 being the independent claims. In an effort to advance prosecution of this application, claims 41, 45, and 53-56 have been amended, and claims 44 and 48 have been canceled without prejudice or disclaimer. No new matter is added with these amendments. For at least the reasons described below, the present application is now in condition for allowance and such disposition is earnestly requested.

**II. Rejection of Claims Under 35 U.S.C. §101**

The Office Action rejects claims 55 and 56 under 35 U.S.C. §101 as allegedly failing to recite a tangible result. As stated in the Office Action, a tangible result for 35 U.S.C. §101 purposes is more than just a thought or a computation; it must have real-world value rather than an abstract result.

Applicants assert that amended claim 55 comprises a feature that yields a tangible result. For example, claim 55 recites *transmitting for display the one or more elements close in meaning to the larger set of search terms*. Claim 56 includes this feature by way of its dependency on claim 55. This recitation is similar to the recitations in claims 16-48, which the Office Action agreed produced a tangible result sufficient to satisfy the requirements of 35 U.S.C. § 101. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 101.

**III. Rejection of Claims Under 35 U.S.C. §102(b)**

The Office Action rejects claims 41, 43, 45, 47, and 53-55 under 35 U.S.C. §102(b) as allegedly being anticipated by European Pat. App. EP 0,597,630 to Addison et al. ("ADDISON"). While the Applicants disagree with the propriety of these rejections, independent claims 41, 45, 53, 54, and 55 have been amended in an effort to advance prosecution. The independent claims have been amended to incorporate at least some features of

claims which depend therefrom—which are currently subject to 35 U.S.C. § 103 rejections.

These amendments render moot the previous rejections under 35 U.S.C. § 102.

#### **IV. Rejection of Claims Under 35 U.S.C. §103(a)**

The Office Action rejects claims 16-40 and 49-52 under 35 U.S.C. §103(a) as allegedly being unpatentable over US. Patent No. 6,134,532 to Lazarus et al. (“LAZARUS”) in view of ADDISON in view of U.S. Patent No. 6,298,348 to Eldering et al. (“ELDERING”). The Office Action also rejects claims 42, 44, 46, 48, and 56 under 35 U.S.C. §103(a) as allegedly being unpatentable over ADDISON in view of ELDERING.

References cannot be combined if the combination would result in an inoperable system, or if the references teach away from the combination. Applicants respectfully submit that the rejections of claims 16-40, 44, 46, 48-52, and 56 fail to meet the above criteria to establish a *prima facie* case of obviousness.

Independent claim 16 recites:

A method for displaying documents responsive to a received concept comprising:

determining one or more concepts close in meaning to the received concept;

identifying one or more documents related to the received concept or one or more concepts close in meaning to the received concept; and

transmitting for display the one or more documents *based on an order, the order corresponding to the relationship between monetary values determined for each of the one or more documents identified as related to the received concept or the concepts close in meaning to the received concept* (emphasis added).

Claim 16 is allowable over the proposed three-way combination of LAZARUS, ADDISON, and ELDERING. The Office Action acknowledges that neither LAZARUS nor ADDISON disclose a method involving *transmitting for display the one or more documents*

*based on an order, the order corresponding to the relationship between monetary values determined for each of the one or more documents identified as related to the received concept or the concepts close in meaning to the received concept.* (see Office Action, pg. 17). The Office Action asserts that it would have been obvious, in view of ELDERING, to order retrieved documents based upon the relationship between monetary values determined for each of the identified documents. (see Office Action, pg. 18). Specifically, the Office Action relies on an excerpt from ELDERING, which states that “if an advertisement is found to be highly correlated with a consumer’s demographics and product preferences, a relatively high price can be charged for transmitting the advertisement to the consumer.” (see ELDERING col. 3, lines 46-56, cited at Office Action, pg. 18). Applicants respectfully disagree that the ELDERING teaching is sufficient to cure the deficiencies of LAZARUS and ADDISON.

**A. The Three-way Combination of LAZARUS, ADDISON, and ELDERING is Improper Because ELDERING’s Use of Demographic Information to Choose Advertising is Incompatible With the LAZARUS/ADDISON System That Uses Search Terms Or Concepts to Choose Advertising.**

**1. LAZARUS explicitly teaches away from a combination with ELDERING**

Combining ELDERING with the combination of LAZARUS and ADDISON in an attempt to arrive at the claimed invention is improper because LAZARUS explicitly teaches away from a combination with ELDERING. There is no reason to combine references if one of the references teaches away from its combination with another source. *See Tech Air, Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1353 (Fed. Cir. 1999). A reference teaches away when a person of ordinary skill, upon reading the reference, (1) would be discouraged from following the path set out in the reference, or (2) would be led in a direction divergent from the path that was taken by the applicant. *Id.* The Supreme Court recently affirmed this principle by stating that “[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” *KSR Int’l Co.* at 12.

Here, LAZARUS teaches away from a combination with ELDERING. LAZARUS describes how the availability of Internet services has allowed consumers to have higher levels of control over information they retrieve; much more control than exists with conventional broadcast models such as radio or television. LAZARUS describes that in an Internet services

setting, users should similarly have control over the advertisements they see. (see LAZARUS col. 1 lines 15-24). This teaching is in direct conflict with the ELDERING's teaching of targeting advertising on the basis of demographic information. When advertisements are targeted on the basis of a demographic profile, the consumer has no control of the advertisements she sees. A person of ordinary skill in the art interested in designing a system of advertising where the advertisements correspond to received concepts would have no reason to borrow from—or even look at—a system that targets advertisements based on a demographic profile.

Further, LAZARUS explicitly recites disadvantages of the targeting techniques described in ELDERING. For instance, at Table 1 (see LAZARUS column 1 line 60 – column 2 line 27), LAZARUS describes the disadvantages of “knowledge base techniques” as (1) providing poor clickthrough; (2) requiring maintenance of knowledge base; (3) costly to maintain; (4) cannot incorporate observed user behavior. The demographic information gathering described in ELDERING is a “knowledge base technique” in that the gathering of demographic information is an attempt to gather knowledge about that person to more carefully target advertisements. Quite clearly, LAZARUS teaches away from such techniques.

2. The proposed modification to the LAZARUS/ADDISON combination changes its principle of operation.

The proposed modification to LAZARUS/ADDISON is improper because it changes the principle of operation of the combined teachings of LAZARUS and ADDISON. If a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facia* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959); MPEP § 2143.01(IV).

The Office Action proposed a modification that is contrary to the general theme and principle operation of the combination of LAZARUS and ADDISON. As noted above, ELDERING uses pre-gathered demographic information as a way of targeting advertisements. This requires that information be known about the consumer **before** the advertisement can be targeted. If these teachings were to be adopted by the combination of LAZARUS/ADDISON, the combined system would target advertisements based on pre-gathered demographic data rather than search terms received by a user. This directly conflicts with the cited combination of LAZARUS/ADDISON. As a result, such a modification is irreconcilable with the manner in

which the LAZARUS/ADDISON system would operate. Further, such a modification is irreconcilable with the recited features in the claim. So, in addition to changing the principle of operation of the LAZARUS/ADDISON references, the addition of ELDERING results in a three-way combination of teachings that in no way teaches or suggests all of the features of independent claim 16.

Therefore, in view of the above, Applicants respectfully submit that claim 16 is allowable over the three-way combination of LAZARUS, ADDISON, and ELDERING and respectfully request withdrawal of the rejection of independent claim 16. Should the Examiner maintain the rejection, it is respectfully requested that the Examiner address in detail the above arguments.

### 3. ELDERING is generally not combinable with LAZARUS or ADDISON

The teachings of ELDERING do not lend themselves to be combined with the combined teachings of LAZARUS and ADDISON. LAZARUS is directed to a system and method for delivering targeted entities, such as advertising, coupons, products, and informational content, to users based on their observed behavior. (see LAZARUS col. 4, lines 56-59). The Office Action relies on the background portion of LAZARUS, which discusses displaying documents in response to user-input keywords. The Office Action acknowledges that LAZARUS does not teach or suggest the feature of displaying documents that are identified based on their relation to concepts. (see Office Action, pg. 16). The Office Action relies on ADDISON to cure this deficiency. ADDISON describes a method for resolution of natural-language queries against full-text database. Specifically, ADDISON is directed to building a concept index from a semantic network of word relationships. (see ADDISON pg. 5, lines 45-49). The Office Action modifies LAZARUS by adding in the ADDISON “concept” searching.

The combined teachings of LAZARUS and ADDISON, however, are still deficient with respect to the claimed feature of *transmitting for display the one or more documents based on an order, the order corresponding to the relationship between monetary values determined for each of the one or more documents identified as related to the received concept or the concepts close in meaning to the received concept*. ELDERING does not cure this deficiency. ELDERING is concerned with profiling consumers and providing access to the consumer profile in a secure manner. This consumer profile information may then be used to determine the potential applicability of a given advertisement to that consumer. (ELDERING col. 2, lines 26-30).

Unlike the combined teachings of LAZARUS/ADDISON, ELDERING does not use terms entered by a user to provide that user with targeted advertising. Rather, ELDERING uses pre-gathered consumer profile information, such as demographic information, to target consumers with advertisements. The ELDERING teachings are therefore incompatible with the combined method and system of LAZARUS/ADDISON.

Claim 49 recites “transmission means for transmitting for display the one or more documents based on an order, the order corresponding to the relationship between monetary values determined for each of the one or more documents identified as related to the received concept or the concepts close in meaning to the received concept.” This language similarly recites the element of claim 16 as the function of a means plus function. For similar reasons as discussed above relative to claim 16, claim 49 is also allowable.

Independent claim 23 recites “transmitting for display the one or more advertisements based on an order, the order corresponding to the relationship between monetary values determined for each of the one or more advertisements identified as related to the received concept or the concepts close in meaning to the received concept.” Claim 29 recites “transmitting for display information from the one or more target data elements identified based on an order, the order corresponding to a relationship between monetary values determined for each of the one or more target data elements relative to the at least one concept.” Claim 35 recites “transmitting for display information from the target data elements identified based on an order, the order corresponding to a relationship between monetary values determined for each of the target data elements relative to the concept.” Independent claim 51 recites “transmission means for transmitting for display information from the target data elements identified based on an order, the order corresponding to a relationship between monetary values determined for each of the target data elements relative to the received concept.” Claim 52 recites “transmission means for transmitting display information from the target data elements identified based on an order, the order corresponding to a relationship between monetary values determined for each of the target data elements relative to the concept.” The Office acknowledges (see e.g., Office Action, page 17) that neither LAZARUS nor ADDISON discloses these features and relies on the disclosure of ELDERING. As discussed above, the proposed modification of LAZARUS in

view of ADDISON in view of ELDERING is improper. Accordingly, independent claims 23, 29, 35, 49, 51 and 52 are allowable over the three-way combination of LAZARUS, ADDISON, AND ELDERING for similar reasons to those discussed above.

For the reasons discussed above, independent claims 16, 23, 29, 35, and 49-52 are allowable over the three-way combination of LAZARUS, ADDISON, and ELDERING and withdrawal of the rejections is earnestly solicited. Furthermore, since dependent claims 17-22, 24-28, 30-34, and 36-40 depend upon independent claims 16, 23, 29 and 35 respectively, dependent claims 17-22, 24-28, 30-34, 36-40 are patentable at least by virtue of their dependency from claims 16, 23, 29 and 35. Therefore, Applicants respectfully request that the rejections of claims 16-40, and 49-52 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

The Office Action rejects claims 42, 44, 46, 48, and 56 under 35 U.S.C. § 103 as being unpatentable over ADDISON (as ADDISON was applied to independent claims 41, 45, and 55) and further in view of ELDERING. As is stated above, independent claims 41, 45, and 55 have been amended—for purposes of advancing prosecution—to at least partially incorporate features of previous dependent claims 44, 48, and 56. The Office action rejected these dependent claims 44, 48, and 56 under 35 U.S.C. § 103.

The currently-amended independent claims 41, 45, and 55 are allowable over the cited two-way combination of ADDISON and ELDERING. These claims now recite features similar to those discussed above with respect to claims 16, 23, 29, 35, and 49-52. These features—which are discussed above as being allowable over the cited three-way combination—are allowable over the two-way combination of ADDISON and ELDERING for at least the same reasons. Accordingly, claims 41-43, 45-47, 53-53 (which have been similarly amended), and 55-56 are allowable over the cited references. Applicants respectfully request that the rejection to claims 41-43, 45-47, 53-54, and 55-56 be reconsidered and withdrawn in light of the amendments and corresponding arguments above.

## Conclusion

In view of the above, it is respectfully submitted that this application and all pending claims are in condition for allowance and notice to that effect is respectfully requested. Should the Examiner have any questions, the Examiner is encouraged to contact the undersigned at the telephone number indicated below.

It is believed that no additional fees are due in connection with filing this amendment. However, the Commissioner is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicants also authorize the Commissioner to charge any additional fees to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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